

EXPRESS MAIL NO. TB725162086 US

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ATTORNEY'S DOCKET NO: C0923/7001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Reissue of U.S. Patent No. 4,780,179

For: METHOD FOR PRODUCING PULP FROM PRINTED UNSELECTED
WASTE PAPER

Serial No: 08/054,951 **SOLICITOR**

Applicant: Jean-Marie Clément

Filed: April 27, 1993 **NOV 8 1996**

Examiner: K. Hastings *U.S. PATENT & TRADEMARK OFFICE*

Art Unit: 1303

EXPRESS MAIL CERTIFICATE UNDER 37 CFR §1.10

The undersigned hereby certifies that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the 6th day of November, 1996 and is addressed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231. Express Mail mailing label No. TB725162086.

John Taylor
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Box 8, Attention The Solicitor
Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

REQUEST FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.304(a)(3)(ii)

Sir:

Pursuant to 37 C.F.R. §1.304(a)(3)(ii), Applicant hereby requests an Extension of Time up to and including November 6, 1996, to file the accompanying Notice of Appeal to the Court of Appeals for

the Federal Circuit from the June 26, 1996 Decision by the Board of Patent Appeals and Interferences ("the Decision") rejecting all remaining claims. In accordance with 37 C.F.R. § 304(a)(1), the deadline for filing a Notice of Appeal was August 26, 1996. Applicant's failure to timely file a Notice of Appeal constituted excusable neglect, which resulted in part from the failure of the United States Patent and Trademark Office ("USPTO") to place the proper postage on the envelope which contained the Decision.

FACTS

Mr. Clément is a French citizen, residing in Italy. From January 20, 1995 to the present, Mr. Clément was not represented by U.S. counsel in this matter and all correspondence from the USPTO was sent directly to his residence, which houses his office, in Milan, Italy. (Clément Decl., ¶ 3). Mr. Clément operates his own one-man consulting business, and he is the sole owner of the above-identified Reissue application. (Clément Decl., ¶ 1). As stated in the accompanying Declaration of Jean-Marie Clément, although stamped "Mailed" on June 26, 1996, the Decision did not actually reach the Milan, Italy office of Mr. Clément until August 8, 1996, one month and twelve days from the stamped date. (Clément Decl., ¶ 5). Apparently, initially, the USPTO did not place sufficient postage on the envelope that contained the Decision (Clément Decl., Exh. A), as the envelope had "Return to Sender . . . for \$1.99 additional postage" stamped thereon. (Clément Decl., Exh. B). On August 2, 1996, four days before the Decision arrived at his office, Mr. Clément began a vacation and business trip. (Clément Decl., ¶ 6). Mr. Clément did not return to his office from this trip until August 26, 1996. Id. His office was closed for the entire period from August 2 to August 26. Id.

To timely file a Notice of Appeal, Mr. Clément would have had to file the Notice in the USPTO on the same day it came to his attention. Mr. Clément, who was not experienced in United States patent laws and who was unrepresented by U.S. counsel in this matter, was not aware of the imminent deadline, and reasonably believed he had time to review the Decision, and decide whether to appeal it. (Clément Decl., ¶ 7). It was not until September 17, 1996, after the period for appeal

had expired, that Mr. Clément contacted the undersigned attorneys and inquired as to his right to appeal the Board's Decision. Mr. Clément's letter to the undersigned was not received until about September 27, 1996. (Clément Decl., ¶ 8).

ARGUMENT

Under 37 C.F.R. § 1.304(a)(3)(ii), the commissioner may extend the time for filing an Appeal

Upon written request after the expiration of the period for filing an Appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

Under this rule, the USPTO has adopted a standard which is similar to the standard used in Federal courts for granting extensions. Manual of Patent Examining Procedure, § 1216. For example, Rule 4(a)(5) of the Federal Rules of Appellate Procedure permits a district court, upon a showing of "excusable neglect," to extend the time for filing a Notice of Appeal.

The "excusable neglect" standard is not solely applicable to circumstances beyond a party's control, but is also, under appropriate circumstances, applicable to late filings caused by inadvertence, mistake, or carelessness. Pioneer Inv. Services v. Brunswick Associates, 507 U.S. 380, 113 S.Ct. 1489, 1493 (1993). Whether the "neglect" is excusable is an equitable determination, taking account of all relevant circumstances surrounding the party's omission. Id. at 1498. Among the circumstances to be considered are 1) the danger of prejudice to other parties, 2) length of delay and its potential impact on judicial proceedings, 3) the reason for the delay, 4) whether the delay was in the reasonable control of the movant, and 5) whether the movant acted in good faith. Id.

The present case reflects an example of a common circumstance that warrants a finding of excusable neglect, that is, where a party fails to timely learn of an adverse judgment against the party. In re Cosmopolitan Aviation Corp., 763 F.2d 507, 514 (2nd Cir. 1985); See also, Brotherhood of Railway Carmen Div. of Trans. Communications Int'l Union v. Chicago & North Western Trans. Co., 964 F.2d 684, 686 (Excusable neglect found where party "through no fault of its own, failed to learn of the entry of the March 21 order."). In Brignoli v. Balch Hardy & Scheinman, Inc., 739 F.Supp. 936 (S.D.N.Y. 1990), counsel for the appealing party did not learn of entry of judgment

because of a change of address and failure of the party's counsel to review and act upon notice of the entry of the Opinion appearing in the New York Law Journal. Id. at 938. As a result, counsel filed the notice of appeal almost a month after the deadline for filing an appeal. Id. This was found to constitute excusable neglect, despite the fact that the "ignorance must be laid, in part, at . . . [the] firm's doorstep, for failing to search the notices of orders published in the Law Journal." Id. The court reasoned that the neglect was excusable since in the past, the court had promptly provided opinions and orders to the parties by mail, thus the parties were entitled to rely on that promptness. Id. Similarly, in the present circumstances, Mr. Clément reasonably relied upon the USPTO to promptly send any correspondence to him related to this matter, as they had done in the past.

Under the standard enunciated by the Supreme Court, and in light of the foregoing cases that have found excusable neglect, the circumstances here clearly warrant an extension. Considering the Pioneer factors listed above, there is clearly no prejudice to other parties here as the appeal arises from an ex parte reissue application. There is no potential impact or disruption of proceedings from granting the extension, as the case now lies abandoned, and all proceedings have terminated. (Clément Decl., Exh. C). As stated above, the delay was due in large part to circumstances beyond the control of Mr. Clément, i.e., the late arrival of the Decision due to inadequate postage by the USPTO and the timing of Mr. Clément's trip. (Clement Decl., ¶¶ 5 and 6). See In re Cosmopolitan, 763 F.2d at 514. ("[F]ailure to hear that judgment has entered may be the basis for a finding of excusable neglect, as may uncontrollable delays in mail delivery, unpredictable events affecting the feasibility of appeal and plausible misconstructions but not mere ignorance of the law or rules.") (emphasis supplied). Even if Mr. Clément had been aware on the day the Decision came to his attention that the Notice of Appeal was due that very day, Mr. Clément was unable to timely file the notice in the USPTO as he had no U.S. counsel at the time and was in a foreign country. (Clément Decl., ¶ 7). Lastly, Mr. Clément acted in good faith. The Decision contained no notice about the time period for filing a notice of appeal. In Pioneer, a case where excusable neglect was found, the notice was present but peculiarly and inconspicuously placed "without any indication of the

significance of the bar date." Pioneer, 113 S.Ct. at 1500. It was entirely reasonable for Mr. Clément to think that he had time to review the decision and retain U.S. counsel to seek their opinion.

CONCLUSION

In view of the unusual circumstances surrounding this case and considering the above precedent regarding acceptable excusable neglect, Applicant respectfully contends that the facts herein demonstrate excusable neglect and requests that the Request for Extension of Time under 37 C.F.R. §1.304(a)(3)(ii) be granted, and that the accompanying Notice of Appeal be entered as having been timely filed. Further, should this Request be granted, Applicant respectfully requests that the above-identified application be withdrawn from abandonment.

Respectfully submitted

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